

REMARKS

The last Office Action has been carefully considered.

It is noted that claim 6 is rejected under 35 U.S.C. 103 over the Admitted Prior Art in view of the patent to Cho and Dorfman.

Claims 7-9 are rejected under 35 U.S.C. 103 as claim 6 and further in view of the patent to Ross.

Claims 11 and 14 are rejected under 35 U.S.C. 103(a) over the Admitted Prior Art in view of the patent to Sullivan, Cho and Dorfman.

At the same time, claim 13 is considered as directed to a non-elected invention. Claim 8 is objected to and claim 14 is rejected under 35 U.S.C. 112.

In connection with the Examiner's formal objections and rejections, applicants have canceled claims 8 and 13 and amended claim 14 correspondingly. Also claim 6 has been amended substantially as suggested

by the Examiner in his rejection of claim 14. It is believed that the formal grounds for objections and rejections are therefore eliminated.

Turning now to the Examiner's grounds for the rejection of the claims over the art, it is respectfully submitted that the Admitted Prior Art which is applied by the Examiner from page 2 of the specification disclosed in German patent document DE 197 03 038 discloses toy building blocks composed of a solid foam which is produced by extrusion or foaming from a starch material. The solid foam becomes adhesive by moisturizing. This reference clearly does not disclose the new features of the present invention as defined in claims 6 and 14, since in the method defined in claims 6 and 14 an adhesive material is utilized which connects the toy building block with the other element. Thus, this reference taken singly does not teach the new features of the present invention. The Examiner further indicated that the use of a starch-containing adhesive is disclosed in the patent to Dorfman and Cho.

It is again respectfully submitted that in the patent to Cho does not disclose adhesive connection of elements with one another, which elements are composed of a solid foam. The both shells 10 of the toy egg of the patent to Cho are composed of a hard synthetic plastic material such

as polyethylene, polypropylene as explained in column 2 starting from line 1. This reference does not disclose a foam or a material which can become adhesive by moistening. Also, this reference does not contain any hint or suggestion for the use of starch. Cho discloses a water-soluble adhesive in column 1, line 29, which however can not be compared with starch.

The patent to Dorfman also does not disclose toy blocks which are adhesive connected with one another by moistening. After the solution of an outer package the parts contained in the package are not dissolved in the water bed and adhesively connected with one another, but they are obtained individually and separately from one another. This clearly shows that the parts which are contained in the package disclosed in the patent to Dorfman are not water-soluble.

Also, in the patents to Cho and Dorfman the adhesive connection is dissolved by water contact, and the adhesive connection is not provided as in the applicant's invention. This is exactly opposite to the solution proposed by the applicant's invention in accordance with which the adhesive connection is produced instead of dissolved.

None of the references discloses a solid foam as a toy block to be adhesively connected. Neither the shells of the patent to Cho nor the figure in the individual parts of the patent to Dorfman are composed of a solid foam. The patents to Ross and Sullivan also do not disclose solid foams.

It is therefore believed to be clear that none of the references teaches such a toy block or a similar block which is composed of a solid foam and is adhesively connected by moistening, and none of the references disclose a method of manufacturing in accordance with the present invention as defined in claims 6 and 14.

Claim 14 additionally defines that the solid foam is refrigerated to form a pourable material and scattering is performed on the other element after the starch in liquid form has been applied to the other element. The references do not disclose these features as well. The flocking in the patents to Ross and Sullivan is sprayed together with a binding agent and not first the starches applied in a liquid form and subsequently crushed and dispersed.

It is believed that none of the references teaches the new features of the present invention which are defined in claims 6 and 14.

In order to arrive at the applicant's invention from the references which were combined by the Examiner, the references have to be fundamentally modified. In particular they have to be modified by changing them and including into them the features which were first proposed by applicant as defined in claims 6 and 14. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Definitely, the references do not contain any hints or suggestions for such modifications.

The references do not contain any hint or suggestion even for combining the references. In re Fritch, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992) in which it was stated:

"Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absence some teaching or suggestion supporting the combination. Under section 103 teachings of the references can be combined only if their some suggestion or incentive to do so".

Definitely, the references do not contain any suggestion or incentive for the combinations.

It seems that the Examiner makes his conclusion based on the analysis of the present invention, since the references do not contain any suggestions for the new features of the present invention as defined in claims 6 and 14.

In connection with this the following decision is believed to be applicable. In W. L. Gore & Assocs., Inc. V. Garlock, Inc., 220 USPQ 303, 312-13 (Fed. Cir. 1983), it was stated:

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

It is therefore believed that claims 6 and 14 contain the features which are not disclosed in the references, can not be considered from the references taken singly, a combination of the references can not be considered as obvious, and the present invention can not be derived from the references as a matter of obviousness.

Claims 6 and 14 should be considered as patentably distinguishing over the art and should be allowed.

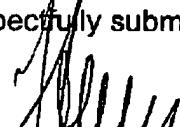
As for the dependent claims, these claims depend on the independent claims, they share its presumably allowable features, and therefore it is respectfully submitted that they should be allowed.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue.

Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,


Michael J. Striker
Attorney for Applicants
Reg. No. 27233

by T. Womarly
12/10/2003